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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,070	04/02/2004	Michael K. Brown	555255-012714	2683
<div>7590 John V. Biernacki, Esq. JONES DAY North Point 901 Lakeside Avenue Cleveland, OH 44114</div>				
EXAMINER				
SAN JUAN, MARTINERIKO P				
ART UNIT		PAPER NUMBER		
2432				
MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/817,070

Applicant(s)

BROWN ET AL.

Examiner

MARTIN JERIKO P. SAN JUAN

Art Unit

2432

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-22 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is a response to an Appeal Brief filed on March 5, 2009.

Claims 1-22, and 25-27 are currently pending.

1. In view of the Appeal Brief filed on March 5, 2009, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Gilberto Barron Jr./
Supervisory Patent Examiner, Art Unit 2432

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 1-2, 4-5, 11-19, 21-22, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lord [US 2004/0168055 A1], and further in view of Hope [US 2003/0079125 A1].

Regarding claim 1, Lord teaches a method for handling on a wireless mobile communication device a secure message to be sent from the wireless mobile communication device to a recipient [Lord 2: 0026], comprising the steps of: receiving data at the wireless mobile communication device about a security key associated with the recipient [Lord 6: 0140] [Lord 6: 0155] [A recipient's certificate is associated with a public key.]; using the received data to perform a validity check with respect to using the security key associated with the message recipient to send a secure message to the recipient [Lord 6: 0156] [Lord 9: 0255]; Lord does not explicitly teach wherein an issue exists due to the validity check; determining a reason for the validity check issue; wherein the reason for the validity check issue is provided via a user interface on the mobile device.

Hope teaches an online certificate validation [Hope 4: 0046] wherein an issue exists due to a validity check [Hope 3: 0037 --revocation corresponds to an issue]; and wherein the reason for the validity check issue [Hope 4: 0038 --Each entry contains a revocation date and optionally a reason the certificate was revoked.] is provided via a user interface on the mobile device [Hope 4: 0046].

It would have been obvious to one of ordinary skilled in the art at the time of invention to modify Lord by providing a reason for any check validity issue as taught by Hope. The suggestion/motivation would have been to ease the resolving of validity check issues by using the provided reason when sending a secure message with the mobile device.

Regarding claim 2, Lord in view of Hope teaches the method of claim 1, wherein a message is provided via the user interface indicating that a problem exists with respect to sending the secure message to the recipient in addition to indicating the reason related to the problem [Hope 3: 0037 --Certificate revocation is a problem with respect to sending the secure message to the recipient.].

Regarding claim 4, Lord in view of Hope teaches the method of claim 1, wherein the security key is a public key, wherein a user composes the secure message, wherein the composed message is to be encrypted using the recipient's public key [Lord 9: 0239].

Regarding claim 5, Lord in view of Hope teaches the method of claim 4, further comprising the steps of: creating a list of all recipients for the composed message [Lord

7: 0185 --buddylist]; receiving data about the recipients' public keys that includes certificate information associated with the recipients [Lord 7: 0182]; and performing the validity check with respect to the certificate information associated with the recipients [Lord 6: 0156].

Regarding claim 11, Lord in view of Hope teaches the method of claim 5, further comprising the step of collating certificates that correspond to the recipients before performing the validity check [Lord 7: 0183].

Regarding claim 12, Lord in view of Hope teaches the method of claim 6, wherein the message is to be encrypted using a Secure Multipurpose Internet Mail Extensions (S/MIME) scheme or a Pretty Good Privacy (PGP) scheme [Lord 7: 0181].

Regarding claim 13, Lord in view of Hope teaches the method of claim 1, wherein the received data about the security key associated with the recipient includes whether a recipient's certificate is permitted to be used [Lord 9: 0237]; wherein the validity check issue indicates that the recipient's certificate is not permitted to be used [Lord 9: 0248-0251].

Regarding claim 14, Lord in view of Hope teaches the method of claim 13, wherein the data about whether the recipient's certificate is permitted to be used is based on a usage field contained in the certificate [Lord 9: 0237].

Regarding claim 15, Lord in view of Hope teaches the method of claim 13, wherein the data about whether the recipient's certificate is permitted to be used is based on a control file installed on the mobile device that specifies which certificates are allowed to be used [Lord 8: 0227].

Regarding claim 16, Lord in view of Hope teaches the method of claim 1, wherein the issue involves a validity check failure [failure of certificate validity, ie. revoked certificates], said method further comprising the step of providing the reason of the validity check failure to the user interface on the mobile device.

Regarding claim 17, Lord in view of Hope teaches the method of claim 1, wherein the received data about the security key associated with the recipient includes strength of the recipient's certificate [Lord 10: 0279 --algorithm and key strength]; and wherein the validity check issue is directed to whether the recipient's certificate is permitted to be used based upon the strength of the recipient's certificate [Lord 10: 0279-0280 -- strength negotiations].

Regarding claim 18, Lord in view of Hope teaches the method of claim 1, wherein the received data about the security key associated with the recipient includes whether the recipient's certificate is trusted [Lord 9: 0235], and wherein a decision to include a recipient for a secure message is based upon whether the recipient's certificate is

trusted [Lord 9: 0245 --certificate should chain to a trusted root certificate.].

Regarding claim 19, Lord in view of Hope teaches the method of claim 1, wherein the received data about the security key associated with the recipient includes validity and revocation status of a recipient's certificate [Lord 6: 0156] [Lord 9: 0255], and wherein a decision to include the recipient for the secure message is based upon the validity and revocation status of the recipient's certificate [Lord 9: 0248].

Regarding claim 21, Lord in view of Hope teaches the method of claim 1, wherein means for providing a wireless network and means for providing a message server are used to transmit the secure message from the mobile device [Lord 2: 0026].

Regarding claim 22, Lord in view of Hope teaches the method of claim 1, wherein the mobile device is a handheld wireless mobile communications device or a personal digital assistant (PDA) [Lord 2: 0026].

Claims 25 and 27 are rejected under the same rationale as claim 1.

Regarding claim 26, Lord in view of Hope teaches a wireless mobile communication device that handles a secure message to be sent from the wireless mobile communication device to a recipient, comprising: a certificate store to store certificate data [Lord 6: 0139]; means for using the stored certificate data to perform a validity

check with respect to using the recipient's security key for sending the secure message to the recipient [Lord 9: 0255]; wherein an issue exists due to the validity check; means for determining a reason for the validity check issue [Hope 3-4: 0037-0038]; and means for providing the reason for the validity check issue via a user interface of the mobile device [Lord 10: 290-291].

2. Claims 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lord [US 2004/0168055 A1], and further in view of Hope [US 2003/0079125 A1] and Janacek [US 6684248 B1].

Regarding claim 3, Lord in view of Hope teach the method of claim 1, but does not teach further comprising the step of resolving the validity check issue through use of the information provided in the validity check reason, wherein the secure message is sent after resolution of the validity check issue by the user.

Janacek teaches a method of sending messages comprising the step of resolving validity check issues, wherein the secure message is sent after resolution of the validity check issue by the user [Janacek 5: 60-65].

It would have been obvious to one of ordinary skilled in the art at the time of invention to modify Lord in view of Hope by being able to resolve validity issues when sending a message as taught by Janacek. The suggestion/motivation would have been for the user to be assured of any messages sent to recipients are without any issues or problems, since issues or problems are resolved before sending the message. Lord in view of Hope, and Janacek would have taught all the limitations as claimed.

3. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lord [US 2004/0168055 A1], and further in view of Hope [US 2003/0079125 A1] and Bandini [US 2002/0169954 A1].

Regarding claim 20, Lord in view of Hope teaches the method of claim 1, wherein the message is sent to the recipient.

Lord in view of Hope does not teach wherein the message is sent to the recipient despite notification of the validity check issue.

Bandini teaches wherein a message is forwarded to the recipient despite notification of an issue [Bandini 9: 0064 --messages in retry queue are sent to the recipient despite the issue notification].

It would have been obvious to one of ordinary skilled in the art at the time of invention to retry the sending of the message to the recipient despite an issue notification as taught by Bandini. The suggestion/motivation would have been to give the recipient an opportunity to resolve the validity check issue by attempting to read the encrypted message.

4. Claims 6, and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lord [US 2004/0168055 A1], and further in view of Grimmer [US 5774552].

Regarding claim 6, Lord teaches a method for handling on a wireless mobile communication device a secure message to be sent from the wireless mobile communication device to a recipient [Lord 2: 0026], comprising the steps of:

receiving data at the wireless mobile communication device about a security key associated with the recipient [Lord 6: 0140] [Lord 6: 0155] [A recipient's certificate is associated with a public key.]; using the received data to perform a validity check with respect to using the security key associated with the message recipient to send a secure message to the recipient [Lord 6: 0156] [Lord 9: 0255]; and determining whether a certificate for an intended recipient can be located [Lord 6: 0139-0140]. Lord does not explicitly teach wherein the validity check determines whether a certificate for an intended recipient can be located; wherein an issue exists due to the validity check; determining a reason for the validity check issue; providing as a validity check reason that the intended recipient's certificate was not located; and wherein the reason for the validity check issue is provided via a user interface on the mobile device. Grimmer teaches a validity check determining whether a certificate for an intended recipient can be located [Grimmer Fig 12, Itm 346]; wherein an issue exists due to the validity check [Grimmer Fig 12, Itm 348 --error occurrence/number]; determining a reason for the validity check issue [Grimmer Fig 12: Itm 348 --error message]; providing as a validity check reason that the intended recipient's certificate was not located [Grimmer Fig 12: Itm 348 --error message] and wherein the reason for the validity check issue is provided via a user interface on the mobile device [Grimmer Fig 12: Itm 348 --Report error].

It would have been obvious to one of ordinary skilled in the art at the time of invention to modify Lord by having a validity check based on determining whether a certificate for an intended recipient can be located as taught by Grimmer. The suggestion/motivation

would have been for a user on the mobile device or client to be able to act on issues on whether or not a certificate for an intended recipient has been located.

Regarding claim 9, Lord in view of Grimmer teaches the method of claim 6, further comprising the step of: determining whether the certificate for the intended recipient is locally available on the mobile device [Lord 6: 0139 --attempting to locate a certificate in a certificate store teaches the determining.].

Regarding claim 10, Lord in view of Grimmer teaches the method of claim 6, further comprising the step of: determining whether the certificate for the intended recipient is remotely available [Lord 6: 0141 --creating a certificate request to the S/AIM subscriber database teaches the determining being remotely available.].

5. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lord [US 2004/0168055 A1], and further in view of Grimmer [US 5774552], and Janacek [US 6684248 B1].

Regarding claim 7, Lord in view of Grimmer teaches the method of claim 6, but does not teach further comprising the step of removing a recipient whose certificate was not located before sending a secure message to another recipient.

Janacek teaches a method of sending messages comprising the step of removing invalid recipients before sending a secure message to another recipient [Janacek 5: 66 --Upon successfully providing all valid email addresses...].

It would have been obvious to one of ordinary skilled in the art at the time of invention to modify Lord in view of Grimmer by being able to remove invalid recipients before sending a secure message to another recipient as taught by Janacek. The suggestion/motivation would have been for the user to be assured of any messages sent to recipients are without any issues or problems, since issues or problems are resolved before sending the message.

Lord in view of Grimmer and Janacek would have taught all the limitations of claim 7.

Regarding claim 8, Lord in view of Grimmer teaches the method of claim 6 but does not teach further comprising the step of canceling sending the message to a recipient whose certificate was not located.

Janacek teaches a method of sending messages comprising the step of canceling sending the message to an invalid recipient [Janacek 5: 63-64].

It would have been obvious to one of ordinary skilled in the art at the time of invention to modify Lord in view of Grimmer by being able to cancel the sending of messages to invalid recipients as taught by Janacek. The suggestion/motivation would have been for the user to be assured of any messages sent to recipients are without any issues or problems, since issues or problems are resolved before sending the message.

Lord in view of Grimmer and Janacek would have taught all the limitations of claim 8.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARTIN JERIKO P. SAN JUAN whose telephone number is (571)272-7875. The examiner can normally be reached on M-F 8:30a - 6:00p EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Martin Jeriko San Juan/
Examiner, Art Unit 2432

/Gilberto Barron Jr./
Supervisory Patent Examiner, Art Unit 2432